

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s): David K Gifford
Appl. No.: 09/711,511
Conf. No.: 8013
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Title: DIGITAL ACTIVE ADVERTISING
Art Unit: 3623
Examiner: Susanna M. Meinecke Diaz
Docket No.: 115274-015

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on November 22, 2006. This Appeal is taken from the Final Rejection in the Office Action dated June 22, 2006, The Advisory Action dated October 4, 2006 and Notice of Panel Decision from Pre-Appeal Brief Review dated December 27, 2006.

I. REAL PARTY IN INTEREST

The real party in interest for the above-identified patent application on Appeal is Soverain Software LLC by virtue of an Assignment dated August 26, 2004 and recorded at reel 015083, frame 0204 in the United States Patent and Trademark Office.

II. RELATED APPEALS AND INTERFERENCES

Appellants' legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

III. STATUS OF CLAIMS

Claims 1-4 and 23 are pending in the above-identified patent application. Claims 1-4 and 23 have been rejected. Claims 1-4 and 23 are being appealed in this Brief. A copy of the appealed claims is included in the Claims Appendix.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed on June 22, 2006. A Response was filed by Appellant on September 22, 2006, and the Office issued an Advisory Action on October 4, 2006. Appellant filed a Notice of Appeal and a Pre-Appeal Brief Conference Request on November 22, 2006. On December 27, 2006, the Pre-Appeal Brief Panel issued a decision to allow the present application to proceed to the BPAI, since it was alleged that at least one actual issue for appeal existed. A copy of the Final Office Action, the Advisory Action and Notice of Panel Decision from Pre-Appeal Brief Review are respectively attached as Exhibits A-C in the Evidence Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A summary of the invention by way of reference to the drawings and specification for each of the independent claims is provided as follows:

Independent claim 1 is generally directed to a network sales system (200, FIG. 1). The network sales system includes a plurality of buyer computers (61, 62) and at least one merchant computer (63, 64) interconnected by a communications network (67). Means at each merchant computer is claimed for maintaining and providing a database of digital advertisements (page 10, line 23 - page 11, line 19). The means for maintaining and providing a database of digital advertisements is disclosed in an exemplary embodiment in the specification as one or more computer databases that provide digital advertisements over a packet-switched network (page 1, line 5-9; page 5, line 24 - page 6, line 3; page 10, line 14 - page 11, line 6). The means at each merchant computer for maintaining and providing a database of digital advertisements also include: (1) means for storing the digital advertisements, each digital advertisement including a product abstract (means for storing disclosed as computer database, see above; see also page 6, line 25 - page 7, line 5), and (2) means for communicating a digital advertisement to a buyer computer over the network using Internet transfer protocols in response to a network request from the buyer computer (packet-switched network, see above, see also page 11, lines 7-19).

The network sales system of claim 1 also includes means at each buyer computer for requesting, displaying, and responding to digital advertisements. The means at each buyer computer for requesting, displaying and responding to digital advertisements is disclosed in the specification in an exemplary embodiment as being software implemented on a user computer to allow requests for advertisements (page 6, line 25 - page 7, line 3; FIGs. 3, 8, 9). Furthermore, the claims recite that the means at each buyer computer for requesting, displaying and responding to digital advertisements also comprise (1) means responsive to a user inquiry for selecting a merchant computer and obtaining a digital advertisement for a product from said database of advertisements at said merchant computer, and (2) display means for displaying said advertisement. The means responsive to a user inquiry for selecting a merchant computer and obtaining a digital advertisement is disclosed in the specification in an exemplary embodiment as software implemented on a computer communicating over a packet-switched network (FIG. 6;

page 13, line 13 - page 14, line 8). The display means for displaying the advertisement is a computer screen (see FIG. 2, page 11, lines 20 et al.)

The network sales system of claim 1 also includes purchase means responsive to a user request for communicating a purchase message to said merchant computer. Purchase means is disclosed in the specification under an exemplary embodiment as software implemented on a computer that allows a user to link to the merchant site (FIGs. 3-4, page 12, line 7 - page 13, line 8). The network sales system of claim 1 also includes account identification means for transmitting the user's account information to said merchant computer. The account identification means is disclosed in the specification in an exemplary embodiment as software implemented on a computer where merchants obtain account information from purchasing buyer computers (FIG. 4, page 12, line 19 - page 13, line 8; page 14, lines 9-19)

The merchant computer of claim 1 also comprises authorization means to authorize the purchase message by sending messages into a financial system network (FIGs. 14-16), and fulfillment means to send said product to user conditional on approval of said authorization means. The authorization means is disclosed in the specification under an exemplary embodiment as software implemented on a payment computer or merchant computer to authorize user purchases (page 14 line 15 - page 15, line 10). The fulfillment means is disclosed in the specification under an exemplary embodiment as software implemented on the merchant computer to fulfill the transaction (FIG. 5, page 16, line 5 - page 17 line 9).

Independent claim 4 recites an electronic sales system (200, FIG. 1), where the system includes means for storing a database of digital advertisements, where each digital advertisement for a product includes a program (page 7, lines 14-19; page 13, line 24 - page 14, line 8), and means for communicating a digital advertisement to a buyer computer using Internet transfer protocols. The means for storing a database of digital advertisements is disclosed in an exemplary embodiment as one or more computer databases that are stored on a computer (page 10, line 23 - page 11, line 19; page 6, line 25 - page 7, line 5). The means for communicating a digital advertisement to a buyer computer using Internet transfer protocols is disclosed in an exemplary embodiment as executable software stored on a computer that establishes Internet communication upon execution (page 1, lines 5-9; page 5, line 24 - page 6, line 3; page 10, line 14 - page 11, line 19). The buyer computer includes means for displaying and responding to the

digital advertisement, and display means for displaying the digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by said program. The means for displaying and responding to the digital advertisement is disclosed in an exemplary embodiment as executable software stored on a computer that can be interpreted or directly executed to display and respond to a digital advertisement (page 11, lines 7-19; page 13, line 13 - page 14, line 8).

The sales system of independent claim 4 also includes purchase means responsive to a user request for communicating a purchase message to a merchant computer. The purchase means is disclosed in an exemplary embodiment as executable software stored on a computer that initiates a linked message upon execution (page 13, line 13 - page 14, line 8). Fulfillment means at the merchant computer is recited to send the product to the user, where the fulfillment means are disclosed under an exemplary embodiment as executable software on a merchant computer that processes account information in response to a purchase request and schedules a physical product to be shipped via ordinary mail or other means (FIGs. 5-6; page 13, line 9-12; page 16, line 5 - page 17, line 8).

Independent claim 23 recites an electronic sales system including means for storing a database of digital advertisements, where each digital advertisement for a product including a program (page 7, lines 14-19; page 13, line 24 - page 14, line 8). The means for storing a database of digital advertisements is disclosed in an exemplary embodiment as one or more computer databases that are stored on a computer (page 10, line 23 - page 11, line 19; page 6, line 25 - page 7, line 5). Packet-switched means are recited for communicating a digital advertisement using Internet transfer protocols to a buyer computer, where the packet-switched means is recited in an exemplary embodiment as software that provides digital communication over the Internet (page 1, lines 5-9; page 5, line 24 - page 6, line 3; page 10, line 14 - page 11, line 19).

The electronic sales system of claim 23 also recites means at the buyer computer for displaying and responding to the digital advertisement via packet-switched network by executing a portion of the advertisement as a program and performing actions as specified by said program. The means for displaying and responding to the digital advertisement is disclosed in an exemplary embodiment as executable software stored on a computer that can be interpreted or

directly executed to display and respond to a digital advertisement (page 11, lines 7-19; page 13, line 13 - page 14, line 8).

The electronic sales system of claim 23 also recites purchase means responsive to a user request for communicating a purchase message to a merchant computer over a packet-switched network. The purchase means is disclosed in an exemplary embodiment as executable software stored on a computer that initiates a linked message upon execution (page 13, line 13 - page 14, line 8). Fulfillment means at the merchant computer is recited to send the product to the user, where the fulfillment means are disclosed under an exemplary embodiment as executable software on a merchant computer that processes account information in response to a purchase request and schedules a physical product to be shipped via ordinary mail or other means (FIGs. 5-6; page 13, line 9-12; page 16, line 5 - page 17, line 8).

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the Brief. There is no intention to suggest in any way that the terms of the claims are limited to the examples in the specification. As demonstrated by the citations above, the claims are fully supported by the specification as required by law. However, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In short, the specification citations are not to be construed as claim limitations or in any way used to limit the scope of the claims.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-4, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Bush* (US Patent 5,475,585) in view of “ALANTEC: ALANTEC Delivers Another industry First; IP Multicast Routing Support for Desktop Video Conferencing and Broadcast Video” (hereinafter “*Alantec*”). A copy of the *Bush* and *Alantec* references are respectively attached hereto as Exhibits D and E.

VII. ARGUMENT

A. LEGAL STANDARDS

1. Obviousness under 35 U.S.C. § 103

The Federal Circuit has held that the legal determination of an obviousness rejection under 35 U.S.C. § 103 is:

whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made...The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art...Moreover, objective indicia such as commercial success and long felt need are relevant to the determination of obviousness...Thus, each obviousness determination rests on its own facts.

In re Mayne, 41 U.S.P.Q. 2d 1451, 1453 (Fed. Cir. 1997).

In making this determination, the Patent Office has the initial burden of proving a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d 1955, 1956 (Fed. Cir. 1993). This burden may only be overcome “by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings.” *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). “If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1444 (Fed. Cir. 1992).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5, U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986) Finally, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q., 580 (CCPA 1974).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir.

1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Of course, references must be considered as a whole and those portions teaching against or away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc.*, 796 F.2d 443 (Fed. Cir. 1986). “A prior art reference may be considered to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant.” *Monarch Knitting Machinery Corp. v. Fukuhara Industrial Trading Co., Ltd.*, 139 F.3d 1009 (Fed. Cir. 1998), quoting, *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

B. THE CLAIMED INVENTION

Independent claim 1 claims a network sales system (200, FIG. 1) that includes a plurality of buyer computers (61, 62) and at least one merchant computer (63, 64) interconnected by a communications network (67). Means at each merchant computer maintain and provide a database of digital advertisements (page 1, line 5-9; page 5, line 24 - page 6, line 3; page 10, line 14 - page 11, line 19). The means at each merchant computer for maintaining and providing a database of digital advertisements also include: means for storing the digital advertisements, each digital advertisement including a product abstract (page 6, line 25 - page 7, line 5), and means for communicating a digital advertisement to a buyer computer over the network using Internet transfer protocols in response to a network request from the buyer computer (page 11, lines 7-19).

The network sales system of claim 1 also includes means at each buyer computer for requesting, displaying, and responding to digital advertisements (page 6, line 25 - page 7, line 3; FIGs. 3, 8, 9). Furthermore, the claims recite that the means at each buyer computer for requesting, displaying and responding to digital advertisements also comprise means responsive to a user inquiry for selecting a merchant computer and obtaining a digital advertisement for a product from said database of advertisements at said merchant computer (FIG. 6; page 13, line 13 - page 14, line 8), and display means for displaying said advertisement (FIG. 2, page 11, line 20 - page 12, line 6).

The network sales system of claim 1 also includes purchase means responsive to a user request for communicating a purchase message to said merchant computer (FIGs. 3-4, page 12, line 7 - page 13, line 8). The network sales system of claim 1 also includes account identification means for transmitting the user's account information to said merchant computer (FIG. 4, page 12, line 19 - page 13, line 8; page 14, lines 9-19).

The merchant computer of claim 1 also comprises authorization means to authorize the purchase message by sending messages into a financial system network (FIGs. 14-16), and fulfillment means to send said product to user conditional on approval of said authorization means (page 14 line 15 - page 15, line 10; FIG. 5, page 16, line 5 - page 17 line 9).

Independent claim 4 recites an electronic sales system (200, FIG. 1), where the system includes means for storing a database of digital advertisements (page 10, line 23 - page 11, line 19; page 6, line 25 - page 7, line 5), where each digital advertisement for a product includes a program (page 7, lines 14-19; page 13, line 24 - page 14, line 8), and means for communicating a digital advertisement to a buyer computer using Internet transfer protocols (page 1, lines 5-9; page 5, line 24 - page 6, line 3; page 10, line 14 - page 11, line 19). The buyer computer includes means for displaying and responding to the digital advertisement, and display means for displaying the digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by said program (page 11, lines 7-19; page 13, line 13 - page 14, line 8).

The sales system of independent claim 4 also includes purchase means responsive to a user request for communicating a purchase message to a merchant computer (page 13, line 13 -

page 14, line 8). Fulfillment means at the merchant computer is recited to send the product to the user (FIGs. 5-6; page 13, line 9-12; page 16, line 5 - page 17, line 8).

Independent claim 23 recites an electronic sales system including means for storing a database of digital advertisements (page 10, line 23 - page 11, line 19; page 6, line 25 - page 7, line 5), where each digital advertisement for a product including a program (page 7, lines 14-19; page 13, line 24 - page 14, line 8). Packet-switched means are recited for communicating a digital advertisement using Internet transfer protocols to a buyer computer (page 1, lines 5-9; page 5, line 24 - page 6, line 3; page 10, line 14 - page 11, line 19).

The electronic sales system of claim 23 also recites means at the buyer computer for displaying and responding to the digital advertisement via packet-switched network by executing a portion of the advertisement as a program and performing actions as specified by said program (page 11, lines 7-19; page 13, line 13 - page 14, line 8).

The electronic sales system of claim 23 also recites purchase means responsive to a user request for communicating a purchase message to a merchant computer over a packet-switched network (page 13, line 13 - page 14, line 8). Fulfillment means at the merchant computer is recited to send the product to the user (FIGs. 5-6; page 13, line 9-12; page 16, line 5 - page 17, line 8).

C. THE REJECTION OF INDEPENDENT CLAIMS 1, 4 AND 23 UNDER 35 U.S.C. §103(A) TO *BUSH*, AND *ALANTEC* SHOULD BE REVERSED BECAUSE THE PATENT OFFICE HAS NOT ESTABLISHED A *PRIMA FACIE* CASE OF OBVIOUSNESS

1. *Bush* and *Alantec*, alone or in combination, fail to disclose or suggest all of the elements of the claimed invention

Specifically, the cited documents, alone or in combination, do not teach or suggest at least “means for communicating a digital advertisement . . . using Internet transfer protocols” and “means for requesting, displaying and responding to digital advertising [presented using Internet transfer protocols]” as recited in claim 1 and similarly recited in claims 4 and 23.

One of the points of contention in the present examination is the application and interpretation of claimed elements presented in means-plus-function (MPF) format. Throughout the present examination, the Examiner has taken the position that only the physical structures, and nothing more, is required in the cited documents to read on claims recited in MPF format, even though the structure includes operative software elements. The Final Office Action stated that, “[r]egarding the means-plus-function language, only the structure needed to perform the recited functionality is read into the claims from the specification. In the instant case, a processor, storage device, and network (as taught by the *Bush* reference) are needed to perform the recited functionality. The specific network transfer protocols and hypertext conventions of the WWW are not structural limitations *per se* nor does the specification clarify that they are inherent to the structure corresponding to the recited means-plus-function language” (page 4, Final Office Action, lines 3-9).

It is not understood by the Appellant what further “clarification” is required in the present application with regard to the features reciting “means for communicating a digital advertisement to a buyer computer over the network using Internet transfer protocols in response to a network request” and “means at each buyer computer for requesting, displaying, and responding to digital advertisements” (see also Advisory Action: “[a]pplicant does not specifically point out which

means correspond to which structural elements in the specification”). Appellant is aware that structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim, and that the “duty to link or associate structure to function is the *quid pro quo* for the convenience of employing 112, paragraph 6” (MPEP 2181 (IV)); *Medical Instrumentation and Diagnostic Corp. v. Elekta AB*, 344 F.3d 1205, 1218, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003).

The specification in the present application clearly discloses a packet-switched network (i.e., the Internet) through which each merchant computer, configured with executable software, communicates a digital advertisement to a buyer computer over the network using Internet transfer protocols in response to a network request. The network sales system of the present application (FIG. 1, 200) is disclosed as a plurality of buyer computers (61, 62), merchant computers (63, 64), and a payment computer (68) interconnected over a network 67, where each merchant computer has a respective digital advertisement database (65) (page 10, lines 14-22). The network sales system utilizes an underlying software architecture, disclosed on page 11, lines 7-19 that comprises HTML, HTTP and URL’s as mechanisms for transmitting documents within the network.

When communicating digital advertisements (FIGs. 3 and 6), an initial user inquiry 19 from the buyer computer results in an HTTP request 20 for a specific document with a specified URL, which also identifies the merchant computer. The merchant computer retrieves a document according to the URL and returns it to the buyer computer (page 13, lines 13-23). Under an alternate embodiment, the document is executed as a program originating from the merchant computer (page 13, lines 24 - page 14, line 8). On page 11, lines 7-19, the Specification provides:

The software architecture underlying the particular preferred embodiment is based upon the hypertext conventions of the World Wide Web. Appendix A describes the Hypertext Markup Language (HTML) document format *used to represent digital advertisements*, Appendix B describes the HTML forms fill out support in Mosaic 2.0, Appendix C is a description of the Hypertext Transfer Protocol (HTTP) between buyer and merchant computers, and Appendix D describes how documents are named with Uniform Resource Locators (URLs) in the network of computers. A document is defined to be any type of digital data broadly construed, such as multimedia documents that include text, audio, and video, and documents that contain programs.

(emphasis added).

Also, the “means for requesting, displaying and responding to digital advertising” are supported in the specification, for example, on pages 11-13, and discloses buyer computers receiving and linking HTML forms or documents received from merchants over a packet-switched network. In the exemplary embodiments of FIGs. 2-3, the means at each buyer computer for requesting, displaying, and responding to digital advertisements is disclosed as executable linking software that retrieves advertisements and displays them on a computer screen:

Figure 2 shows an overview screen that has been retrieved from a merchant computer by a buyer computer and displayed by the buyer computer. It includes links 1, 2, and 3 that when activated by a user cause the buyer's computer to take specified actions. In the case of link 1, the document shown in Figure 3 is retrieved from a merchant computer and displayed. In the case of link 2, a short audio segment is retrieved from a merchant computer and played. In the case of link 3, the query that can be entered into the query dialog box 4 is sent to a merchant 5 computer, and a document is retrieved from the merchant computer and displayed.

Figure 3 shows a document that contains three digital advertisements. The digital advertisements have been retrieved from the merchant computer after the 10 activation of link 3.

(page 11, line 20 – page 12, line 10).

Appellant has repeatedly pointed out the correlation of the recited means to the hardware and software structural elements, and provided arguments that were consistent with this correlation (e.g., Responses dated March 6, 2006, April 14, 2006, September 22, 2006 and Pre-Appeal Brief Conference Request dated November 22, 2006). However, in each case, Appellant's arguments were summarily dismissed without further detail from the USPTO.

To complicate matters further, the arguments provided in the Office Actions in response appear inconsistent. On one hand, the Office argues that the software structure was not considered because it could not be determined where the specification specifically pointed out which means correspond to which structural elements (see above). On the other hand, the Office Actions have apparently *made these determinations already*, as evidenced by remarks in the Office Actions indicating that, despite the disclosure of operative software elements in the

specification, the software would not be considered as part of the overall structure, and thus not read into the claims (see, e.g., non-final office action dated December 6, 2005: “the use of links, and . . . HTML forms for interacting with users’ does not define any structure *per se* that is disclosed in the specification as necessarily read into the recited ‘means for requesting, displaying and responding to digital advertisements.’”).

Under the MPEP, the USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application (MPEP 2181). If a prior art reference purportedly teaches identity of function to that specified in a claim, then the Examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function (MPEP 2182). If the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning (MPEP 2182).

Appellant submits that the Office has not met the burden imposed by the MPEP to explain how the structures and corresponding functions in *Bush* are the same or equivalent to the present claims. As will be shown in more detail below, the communication channel in which an end user communicates to the system in *Bush* (i.e., dedicated telephone line) is separate and distinct from the broadcast channel that delivers a menu to the user terminal, and the system of *Bush* delivers the purchase message to a different destination from the source of the advertisements (menu). There is no mention of any kind of network transfer protocols or other hypertext conventions of the WWW (i.e., the Internet).

The Non-Final Office Action, which initially set up the reasoning in the enclosed Final Office Action, stated that “*Bush* discloses a processor, storage device, and network which performs the functionality in claims 1, 2 and 4 [*sic*]; therefore, it is understood that *Bush*’s processor, storage device and network are programmed to specifically perform these functions” (bottom of page 3 of Office Action). The Advisory Action repeated this reasoning, stating that “the only structure needed to perform the recited functionality is read into the claims from the specification. In the instant case, a processor, storage device and network (as taught by the *Bush* reference) are needed to perform the recited functionality.” The Office Action has incorrectly maintained that the means-plus-function language is limited to only the physical hardware

defined in the specification, to the exclusion of any software components that may reside therein, or the manner in which the executed software communicates over a network. This approach is inconsistent with that promulgated by the courts and the USPTO:

[T]he application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim. However, if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function . . . If the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning.

See MPEP 2182. The Appellant respectfully submits that the Office Actions have ignored Appellant's arguments showing that different functions are being employed by a different structure in the configuration of *Bush*, namely a video broadcasting system that transmits video menus to a television or video screen via RF carrier signals. Appellant notes that construing means-plus-function claims is a two-step process. In the present rejection, it is apparent that the Office has applied the first step only (i.e., construing the claim "to include the limitations contained in the claim language, and only those limitations"), and has completely vitiated any subsequent analysis that is required by law ("look to the specification and identify the corresponding structure for that function"). MPEP 2182 clearly instructs that "[i]f the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning."

Even if the Board is not persuaded by Appellant's arguments pertaining to 35 U.S.C. §112 paragraph 6, the cited documents, using the interpretation provided by the examiner, nevertheless fail to teach or suggest every limitation contained in the independent claims. *Bush* discloses a video broadcasting system that transmits video menus to a television or video screen via RF carrier signals, and further incorporates credit-card swipers and special keypads for user input (col. 3, lines 21-30; col. 5, lines 34-44, line 65 to col. 6, line 9; col. 7, lines 22-35). *Bush* also discloses a high capacity data input device 202, that loads vendor-specific menus via

external disk storage devices 214 and 216, where the information is transferred to the main CPU 204, which controls the overall data formatting, and transmits the formatted data as parallel data to video interface 212 for subsequent broadcast (col. 4, lines 54-66). Stored advertisement are transmitted *asynchronously* (presumably under an Asynchronous Transfer Mode, which is not done under a packet-switched protocol) from corresponding databases to computer dedicated processor 201. The processor 201 then performs packet formatting and output this data in a synchronous manner (polled by the main CPU 204) via time multiplexing to gather data belonging to various vendors and service providers, assemble the data, and transmit it over the parallel bus to video interface 212. The video interface 212, converts the digital data into video format for broadcast to receivers 26 (col. 5, lines 10-19).

The video files in *Bush* are received for storage/buffering either through an asynchronous transfer from a vendor (201), or through a direct transfer from disk (202). When the video data is being prepared for transmission, the main CPU 204 polls the database and performs time multiplexing to load the data, and then forwards the transmission to the video interface that “[c]onverts the digital data into video format for transmission to receivers” (col. 5, lines 16-19). Even if it is assumed that the loading of video data from the memory to the main CPU is “transmitting video,” it is not being communicated to a buyer computer, and is certainly not being done over a packet-switched network, in which packets are routed between nodes over data links shared with other traffic. Further disclosure in the *Bush* reference that supports the position that packet-switched communication is not utilized is the use of splitters that allows the telephone set 110 and receiver 26 to use the same phone line during operation (col. 5, lines 42-43), and the use of separate, dedicated channels for communication among the difference devices (e.g., see FIG. 1A; col. 2, lines 60-61 (transmission channel 16) and line 65 (transmission channel 20); col. 3, line 27 (transmission channel 28), line 38 (transmission channel 32), and line 52 (transmission channel 48); col. 4, line 18 (transmission channel 24), line 39 (transmission channel 50) and line 48 (transmission channel 64)). Such a structural configuration would be inconcievable under a packet-switched configuration.

Appellant adds that, just because data is “packetized” does not mean that it is being transmitted over a packet-switched network. *Bush* explicitly discloses that the dedicated processor 201 packetizes asynchronous transmissions and forwards them in a synchronous manner to CPU 204. However, the CPU obtains this data via time multiplexing, which is known

in the art as a type of digital multiplexing in which two or more signals or bit streams are physically taking turns on the channel via timeslots. It is also well-known in the art that time multiplexing is not, even under the broadest reasonable interpretation, remotely equivalent to packet-switched communication or Internet protocols. Thus, no packet routing or switching whatsoever is conducted in the disclosure of *Bush*. If anything, *Bush* discloses a RAID-type configuration (via SCSI/ESDI - see col. 5, lines 3-5, 20-23) for obtaining video data, which is an entirely different structure which relies on different protocols from that disclosed in the present application. Simply because *Bush* discloses “a processor, storage device and network” does not give the Office license to pick and choose elements from the prior art, irrespective of their function and structure, and ignore other elements essential to their operation (e.g., video converter, time multiplexing).

The Office has, thus far, failed to reconcile how the use of a video interface converter which produces raw video signals, is a “structure” that is the same or equivalent to the structure described in the specification which corresponds to the claimed means plus function elements. The use of a video interface in the present claims is wholly inapplicable. However, the absence of a video interface under the teaching of *Bush* renders the entire system inoperable, and alone renders the structure materially different from the present claims. Appellant respectfully rebuts the examiner’s assertion that “*Bush* transmits video (including related advertisements) over a packet-switched network” (see Final Office Action page 7, 4th paragraph). This is simply not correct under the disclosure of *Bush*.

Additionally, *Bush* discloses a transmission being made by a transmitting source using a video signal that includes characters generated from a video character generator 206 (col. 1, lines 56-67; col. 3, lines 1-7; col. 5, lines 50-59; col. 6, lines 25-34). This also has not been explained by the Office how the structural and functional requirement for such a device correlates to the present claims. Also, the “means for requesting, displaying and responding to digital advertising” are supported in the specification, for example, on pages 11-13, and discloses buyer computers receiving and linking HTML forms or documents received from merchants over a packet-switched network. In contrast, *Bush* discloses a structure utilizing multiple PLL synthesized tuners (215-16), channel control demodulators (217), demodulator data separators (214) and RF switches (213) to request, display and respond to video advertisements (col. 5, line 45-col. 6, line 9; col. 7, lines 6-21). Again, the Office has ignored these elements in formulating

the rejection and continues to be silent in explaining how this structure is the same or equivalent to the configuration disclosed in the present application.

Appellant also notes that claim 1 recites that the “plurality of buyer computers and at least one merchant computer are *interconnected* by a communications network.” This means that, consistent with packet-switched communication, each of the buyer computers can communicate with the merchant computer *and with each other*. No such configuration is disclosed in *Bush*.

Furthermore, regarding independent claim 4, the claim additionally recites means at the buyer computer for displaying and responding to the digital advertisement comprising display means for displaying the digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by the program. *Bush* merely discloses a video menu that is broadcast from the transmitting source 10, along with prompting data that prompts the user to enter a selection on a keypad (col. 3, lines 1-20; col. 8, lines 3-8). The buyer’s receiver 26 does not “execute” anything related to the digital advertisement, but merely forwards keypad entries or credit-card swipes to a transaction processor in response to a prompt (col. 3, lines 21-34). Due to the fact that the advertisements are television broadcasts containing video text, there is nothing “executable” about the video advertisements whatsoever.

Moreover, regarding claim 23, the claim expressly recites that “packet-switched” communication is used to provide digital advertisements, and to communicate responses from the buyer computer, and to communicate a purchase message to a merchant computer. No such configuration is disclosed in *Bush*. As was explained above, *Bush* does not teach packet-switched communication anywhere in the disclosure.

2. One having ordinary skill in the art would not be motivated to combine *Bush* in view of *Alantec* to arrive at the present claims

Appellant respectfully submits that there is no teaching, suggestion or motivation for one skilled in the art to combine the aforementioned references. *Alantec* discloses an IP multicast routing system where PC’s networked within a LAN can submit A/V messages to a central server (PowerHub), which in turn forwards the traffic to a selected group of users “who can simultaneously participate in video conferences, and other interactive desktop applications”

(paragraph 6). This clearly has no application to *Bush*, and expressly teaches away from the disclosure. *Alantec* teaches that the PowerHub system allows users to multicast content to a server that processes network connections to stream multimedia traffic to selected network nodes, instead of using unicast and broadcast addressing (paragraphs 5 and 6). In contrast, *Bush* expressly relies on broadcasting to transmit television and video character content to users (see, e.g., claim 1).

More importantly, *Bush* clearly does not rely on any computer networking in the transmitting the broadcasts. In contrast to *Alantec*, *Bush*

- (1) does not disclose any type of LAN architecture (*cf.*, *Alantec*, paragraph 3),
- (2) does not disclose the use of personal computers (*cf.*, *Alantec*, paragraph 9),
- (3) clearly does not allow viewers to send video content or advertisements *to each other*, (*cf.*, *Alantec*, paragraph 6)
- (4) expressly relies on standard video transmission for broadcast and does not contemplate IP multicasting (*cf.*, *Alantec*, paragraph 6),
- (5) does not rely on servers for transmitting advertisements among users over a network (*cf.*, *Alantec*, paragraph 3), and
- (6) makes no provision whatsoever for IP communication anywhere in the system (*cf.*, *Alantec*, paragraph 8).

In short, the IP multicast of *Alantec* is nonanalogous art and runs counter to most every feature disclosed in *Bush*. As argued above, *Bush* does not disclose packet-switched communication, and further relies upon a multitude of separate transmission channels to enable communication between the various components. Moreover, the transmission of videos and menus in *Bush* are clearly disclosed as occurring on a standard video channel. It is inconceivable that the IP multicasting of *Alantec* could be incorporated into the RF broadcasting system of *Bush* without essentially gutting and replacing most every essential feature contained within *Bush*. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (MPEP 2143.01).

E. THE PATENTABILITY OF CLAIMS 1, 4 AND 23 RENDERS MOOT THE REJECTIONS OF CLAIMS 2 AND 3

Dependent claims 2 and 3 were also rejected under 35 U.S.C. §103(a) as being unpatentable over *Bush* (US Patent 5,475,585) in view of *Alantec*. Appellants respectfully submit that the patentability of independent claims 1, 4, and 23 as previously discussed renders moot the obviousness rejections of claims 2 and 3. In this regard, the cited art fails to teach or suggest the elements of these claims in direct/indirect combination with their respective independent claims.

VIII. CONCLUSION

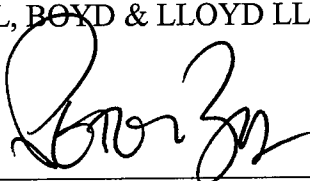
Appellants respectfully submit that Claims 1-4 and 23 are novel and non-obvious in view of the cited references for the reasons previously discussed. Accordingly, Appellants respectfully submit that the rejections under 35 U.S.C. §103(a) are erroneous in law and in fact and should therefore be reversed by this Board.

The Director is authorized to charge \$500 for the Appeal Brief and any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 115274-015 on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY

A handwritten signature in black ink, appearing to read 'Peter Zura', written over a horizontal line.

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